

Reply Brief

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with 37 CFR § 1.6(a)(4).

Dated: October 28, 2011

Electronic Signature for Charles A. Bieneman: /Charles A. Bieneman/

Docket No.: 66703-0014
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lester K. Chu et al.

Application No.: 10/800,444

Confirmation No.: 1779

Filed: March 15, 2004

Art Unit: 3625

For: INFORMATION DISTRIBUTION SYSTEM
AND METHOD THAT ORGANIZES
LISTINGS USING TIERS

Examiner: N. D. Rosen

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer dated September 15, 2011 ("Examiner's Answer" or "Answer"), pursuant to 37 C.F.R. § 41.37, and in furtherance of the Notice of Appeal filed on June 23, 2011, and the Appeal Brief filed on August 10, 2011 ("Appeal Brief"), and appeals the claim rejections of the Examiner in the Final Office Action dated April 28, 2011 ("Final Office Action"). This application was filed on March 15, 2004.

Any fees associated with this Reply Brief are identified in an accompanying transmittal paper.

ARGUMENT**A. The Law.**

The Examiner does not appear to have disagreed with Appellants' statement of the law of obviousness at page 13 of the Appeal Brief.

B. Ground Of Rejection No. 1: Claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, And 48 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille And Bates.**1. The Combination Of Soulanille And Bates Does Not Teach Or Suggest All Of The Elements Of The Claims.**

The combination of Soulanille and Bates fails to teach or suggest numerous elements of Appellants' claims, as set forth in the Appeal Brief and below.

a. "each said group being determined at least in part according to said request."

Independent claim 1 recites in part "each said group being determined at least in part according to said request." As argued in the Appeal Brief (pages 14-15), Bates discloses at most "dividing [search] results into multiple groups" (Bates, Abstract), and does not teach or suggest "each said group being determined at least in part according to said request." According to the Examiner, although Bates discloses grouping listings according to whether URLs for listings have changed since a last search, Bates' groups of listings "are also determined in part on the basis of a current search." (Answer, page 34.) The Examiner stated "if the user enters 'widget' as a search term, he will get a list of URLs relevant to 'widget,' with the URLs grouped as described, but this depends on 'widget' being entered as a search request." (*Id.*, pages 34-35.) The Examiner reasoned that a different search, e.g., for "wadget," would result in "a different set of URLs, grouped differently according to previous searches, if any, on 'wadget.'" (*Id.*, page 35.)

The Examiner's reasoning still fails to establish that Bates' system determines groups "at least in part according to said request." To use the Examiner's example, whether a search is for "widget" or "wadget," Bates will group URLs according to characteristics of URLs, not according to the search request. That is, Bates groups URLs according to those that are new since a last search, those that have changed, those that have not been previously visited, and those that have been previously visited but not changed. (Bates, Abstract.) None of these things depend on "said

request.” Bates at most uses a request to determine what URLs to return, but does not teach or suggest using the request to determine how to group the URLs. The Examiner may be correct that searches for “widget” and “wadget” would return different sets of search results, but with respect to neither set of search results is a request for “widget” or “wadget” used to determine groups of listings. Bates relies exclusively on characteristics of URLs, and not at all on “said request” to determine groups.

In sum, Bates does not teach or suggest “each said group being determined at least in part according to said request.” For at least the foregoing reasons and the reasons set forth in the Appeal Brief, the present rejection of claim 1, and all claims depending therefrom, should be reversed. For similar reasons, the present rejections of claim 48, and all claims depending therefrom, should also be reversed.

b. Soulanille Would Not Have Been Combined With Bates.

As argued in the Appeal Brief (page 15), nothing in either reference would have made possible or obvious a combination of Soulanille with Bates. The Examiner responded that the foregoing recitation of claim 1 “would still be met” where “a search system merely assigned listings to groups for its own purposes, without ordering the listings presented to the user in accordance with the groups, or doing anything else to make the user aware of the existence of the groups.” (Answer, page 35.) The Examiner further stated that the teachings of Bates need not be bodily incorporated into Soulanille to support a finding of obviousness. Accepting *arguendo* the Examiner’s statement of the law, and even accepting *arguendo* that a search system could group listings without making a user aware of the groupings, the Examiner has still given absolutely no explanation as to how or why one of ordinary skill could or would have combined Soulanille’s alleged teaching of tiered listings with Bates’ disclosure of determining groups based on characteristics of URLs.

Further, the Examiner did not address Appellants’ argument that ordering listings according to the heuristics recited in claim 1 would preclude ordering the listings according to the prioritized groups taught by Bates. That is, even if a secondary reference need not be bodily incorporated into the primary reference to support a finding of obviousness, the fact that the secondary reference would have prevented operation of the primary reference, at a minimum, must weigh very strongly against a finding of obviousness. That is, one of ordinary skill could not have had no reason, and

therefore not found it obvious, to use the teachings of a secondary reference in the context of a first reference where doing so would render the first reference unusable.

For least the foregoing further reasons, the rejections of claims 1 and 48, and all claims depending therefrom, should be reversed.

2. Claim 10 Is Separately Patentable.

Claim 10 depends from independent claim 1, and recites in part “said listings belonging to said tier belong to the same said group.” According to the Examiner, the cited references meets the foregoing recitation if some listings belonging to a tier belong to the same group, even if some listings in the tier do not belong to the group. (Answer, page 36.) Thus, as noted in the Appeal Brief (page 16), the Examiner has plainly conceded that, assuming Soulanille and Bates could or would have been combined, at a minimum many instances of search results returned by such combination would not include “said listings belonging to said tier belong to the same said group.” Claim 10 does not recite that “some” listings in a tier belong to the same group, and some listings do not. Instead, claim 10 recites that “said listings belonging to said tier belong to the same said group.” As admitted by the Examiner, the cited references together teach that some listings in a tier do not belong to the same group. Therefore, the cited references cannot render claim 10 obvious.

Thus, for at least the foregoing reasons and the reasons set forth in the Appeal Brief, claim 10 is separately patentable.

3. Claim 17 Is Separately Patentable.

Claim 17 depends from independent claim 1, and further recites “a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier.” As argued in the Appeal Brief, the Examiner has at most speculated that “in the case of someone requesting results on a search term for which no advertiser had bid, such a tier would be absent, and presumably only unpaid listings . . . would be displayed.” (Final Office Action, pages 4-5.) In the Answer, the Examiner did not dispute that the references do not teach the recitation of claim 17, but simply repeated arguments that “the situation of no paid listings could easily arise in the system disclosed by Soulanille.” Appellants respectfully submit that the mere possibility that cited references could be modified to meet a claim recitation, without even any allegation from the

Examiner that the references in any way teach or even suggest the claim recitation, is not enough to state a case of obviousness. For least these reasons, and the reasons set forth in the Appeal Brief, claim 17 is separately patentable, and the rejection of claim 17 should be reversed.

C. Ground Of Rejection No. 2: Claims 2 And 3 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Weidlich.

Claim 2 depends from claim 1, and claim 3 depends from claim 2. Claim 2 recites, “a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier.” As argued in the Appeal Brief (pages 17-19), Weidlich fails to teach or suggest the aforementioned claim recitation.

The Examiner responded to Appellants’ arguments by characterizing Appellants’ argument as being one that “Weidlich lacks any teaching of an ‘administrative subsystem’ to impact the functioning of other subsystems.” The Examiner then stated that “Soulanille discloses an administrative subsystem,” and that it “is sufficient that Weidlich teaches multiple factors for assigning weights to Web pages, and therefore selectively identifying Web pages for inclusion in search results.” (Answer, page 39.) The Examiner has mischaracterized Appellants’ arguments.

Simply put, the proposed combination of Soulanielle and Weidlich could result at most in “an administrative subsystem,” and a system that includes a spider crawling the Internet looking for web pages, which are then compiled to create indices, wherein “[e]ach search engine uses a different algorithm to determine how relevant a Web page is to a user’s query, assigning different weight to such factors as body text, links and meta tags.” (Weidlich, paragraph beginning “it’s important to understand”.) Thus, Weidlich cannot compensate for Soulanielle’s failure to teach or suggest “at least some of said priority metrics to selectively identify said listings for inclusion in said tier” because the proposed combination of these references would result in most ranking web pages in search results, and an administrative subsystem creating tiered listings, without any teaching or suggestion that “priority metrics” could or should be used “to selectively identify said listings for inclusion in said tier.”

Further, as argued in the Appeal Brief (pages 18-19) even if Weidlich teaches or suggests “a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings,” which it does not, Weidlich still fails to teach or suggest, “a plurality of priority metrics wherein said administrative subsystem uses at least some

of said priority metrics to selectively identify said listings for inclusion in said tier.” (Emphasis added.) The Examiner responded to this argument by stating that “a search engine such as those taught by Weidlich necessarily present search results in at least one tier, thus meeting that limitation.” However, search results in only one tier would not require “priority metrics to selectively identify said listings for inclusion in said tier.” Therefore, the Examiner’s reasoning is specious, further demonstrating why the rejection of claim 2 should be reversed.

In sum, for at least any of the foregoing reasons, or the reasons set forth in the Appeal Brief, claim 2, as well as claim 3 depending therefrom, are separately patentable.

D. Ground Of Rejection No. 3: Claims 7, 8, 9, 11, 12, 15, 19, and 37 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates and Might.

Claims 7, 8, 9, 11, 12, 15, and 19 all depend, directly or indirectly, from claim 1. Claim 37 depends from claim 36, which depends from claim 1. Therefore, these claims, while not argued separately in this appeal, are all patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

E. Ground Of Rejection No. 4: Claims 16 and 24 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates and Corn.

Claims 16 and 24 both depend from claim 1. Therefore, these claims, while not argued separately in this appeal, are all patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

F. Ground Of Rejection No. 5: Claims 20 and 21 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates and Littlefield.

Claims 20 and 21 depend, directly or indirectly, from claim 1. Therefore, these claims, while not argued separately in this appeal, are all patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

G. Ground Of Rejection No. 6: Claim 25 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates and Singh.

Claim 25 depends directly from claim 1. Therefore, claim 25, while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

H. Ground Of Rejection No. 7: Claims 28 and 29 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, and Barron.

Claim 28 depends from independent claim 1. Claim 29 depends from claim 28. Claim 28 recites “a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests.” Once again, the Examiner has essentially conceded that the references do not disclose the relevant claim recitation, and contended that the recitation would have been obvious because it allegedly would have been possible within the context of the cited references. (Answer, page 41.) The Examiner’s speculation is not enough to sustain the rejection of claim 28.

As argued herein and in the Appeal Brief, the rejection of claim 28 should be reversed because there is no teaching or suggestion in the references of record for the specific recitations of claim 28: “a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests.” The rejection of claim 29 should be reversed at least by reason of that claim’s dependence from claim 28.

I. Ground Of Rejection No. 8: Claims 28 and 29 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, and Loh.

The reasoning applied above with respect to Ground of Rejection 7, also applies to this Ground of Rejection 8.

J. Ground Of Rejection No. 9: Claims 28 and 29 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, and Thoman.

The reasoning applied above with respect to Ground of Rejection 7, also applies to this Ground of Rejection 9.

K. Ground Of Rejection No. 10: Claim 30 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Schena.

Claim 30 depends from independent claim 1. Claim 30 recites, “[t]he system of claim 1, further comprising a user location, wherein said system automatically includes said user location as part of said request.” As argued in the Appeal Brief (pages 22-23), one of ordinary skill in the art would not have thought it possible to combine Schena with Soulanille, Bates or any other reference. The Examiner did not respond to this argument in the Answer (see page 41). Therefore, for at least

the reasons set forth in the Appeal Brief, claim 30 is separately patentable, and the rejection of claim 30 should be reversed..

L. Ground Of Rejection No. 11: Claim 32 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Mangold.

Claim 32 depends from claim 31, which in turn depends directly from claim 1. Therefore, claim 32, while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

M. Ground Of Rejection No. 12: Claim 33 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Mangold and Mahanta.

Claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Claim 33 recites “a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee.” As argued in the Appeal Brief (pages 23-24), neither Mahanta nor any of the other cited references disclosed that “said number of hits in said period of time influence said variable per-hit fee.”

The Examiner responded to Appellants’ arguments by stating that “Mahanta teaches that the fee for paid ads can be contingent on a minimum number of impressions or clicks-throughs, which means that if the minimum number of hits is not reached, there will be either no fee paid, or a reduced fee.” Accordingly, the Examiner reasoned that “the fee per hit depends on the number of hits, presumably within a period of time.” (Answer, page 41.) Appellants respectfully submit that the Examiner is not entitled to rely on presumptions in making a claim rejection. As explained in the Appeal Brief (page 24), and not disputed by the Examiner, Mahanta includes no explicit teaching or suggestion of hits within a period of time.

The rejection of claim 33 should be reversed at least for the foregoing reasons and the reasons in the Appeal Brief.

N. Ground Of Rejection No. 13: Claim 32 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, and Acres.

Claim 32 depends from claim 31, which in turn depends directly from claim 1. Therefore, claim 32, while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 1.

O. Ground Of Rejection No. 14: Claim 33 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Acres, and Mahanta.

As stated above, claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above and in the Appeal Brief, and the rejection should be reversed.

P. Ground Of Rejection No. 15: Claims 34 and 35 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, and Acres.

1. Claim 34 Is Patentable.

Claim 34 depends from claim 1, and recites, “[t]he system of claim 1, further comprising a plurality of per-hit fee types.” As argued in the Appeal Brief (pages 25-26), Acres fails to teach or suggest at least “a plurality of per-hit fee types” as recited by claim 34. The Examiner responded to Appellants’ arguments that Acres discloses at most one “per-hit fee type,” Acres discloses a click fee and a referral fee that “are both types of per-hit fee, since both depend on an actual hit, and therefore . . . Acres teaches a plurality of per-hit fee types.” (Answer, page 43.) According to the Examiner, the referral fee is a “per-hit fee” because it “is a percentage of the price of a purchase that resulted from the click through.” (Answer, page 43, citing Acres, paragraph 4.) In fact, Acres’ referral fee is a fee that depends on an item being purchased, and not on a click-through, or “hit.” At most, Acres’ referral fee indirectly results from a “hit,” but is not itself in any way a per-hit fee. Indeed, it is likely that a user would “hit,” or click through to, a web page, but then not purchase an item displayed on the web page, i.e., incur the referral fee. Thus, Acres discloses a single click fee, and not “a plurality of per-hit fee types,” as recited in claim 34.

For at least the foregoing reasons and the reasons set forth in the Appeal Brief, claim 34 is separately patentable.

2. Claim 35 Is Separately Patentable.

Claim 35 depends from claim 34, which depends from claim 1. Claim 35 recites, “[t]he system of claim 34, wherein said plurality of listings includes a first listing, wherein said first listing is associated with more than one said per-hit fee type.” The Examiner responded to Appellants’ argument (Appeal Brief, page 26) that there is no teaching or suggestion in any of the prior art for a system “wherein said first listing is associated with more than one said per-hit fee type” by stating that “if it is obvious for listings in general to be associated with a plurality of per-hit fee types, and

Acres makes this obvious, then it is obvious for the first listing in particular.” (Answer, page 43.) However, as argued above with respect to claim 34, Acres does not in fact teach or suggest “a plurality of per-hit fee types.” Further, even if Acres did include such a disclosure, the Examiner has given no reason why one of ordinary skill would have found it obvious to associate a first listing “with more than one said per-hit fee type.” That is, even if “a plurality of per-hit fee types” is obvious, there is no reason why it would have been obvious that “said first listing is associated with more than one said per-hit fee type.”

For at least the foregoing reasons, and the reasons set forth in the Appeal Brief, claim 35 is separately patentable.

Q. Ground Of Rejection No. 16: Claims 38-42 and 44-46 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, “Google Comes Out Ahead,” and Bates.

Independent claim 38 recites in part “each said group being determined at least in part according to said request.” Claim 38, as well as all claims depending therefrom, are patentable for at least the reasons discussed above with regard to claim 1. Moreover, there are additional reasons for the patentability of claims 38-42 and 44-46, discussed below.

1. The Combination Of Soulanille, “Google Comes Out Ahead,” And Bates Does Not Teach Or Suggest All Of The Elements Of Appellants’ Claims.

Claim 38 recites in part that “said administrative rules provide for ordering said listings included in said response,” and that “said administrative rules provide for identifying two or more listings in said response as belonging to a tier identified from a plurality of tiers.” As argued in the Appeal Brief (pages 26-27), Google Comes Out Ahead at most makes a conclusory statement that results returned by Google are “most useful and relevant,” without any disclosure regarding “ordering said listings included in said response,” let alone “said administrative rules provide for ordering said listings included in said response.” The Examiner responded that Google Comes Out Ahead, cited to compensate for Soulanille’s acknowledged failure to “prioritize the listings within other tiers, such as the second tier of non-paid listings, although this might be considered inherent, on the grounds that the order of listings in the second tier would have to be selected somehow,” because Google Comes Out Ahead teaches prioritizing “listings in non-paid tiers returned by search engines.” (Answer, page 45.) In fact, as discussed in the Appeal Brief, Google Comes Out Ahead

discloses at most ranking search results, and does not include any teaching or suggestion of “identifying two or more listings in said response as belonging to a tier identified from a plurality of tiers,” nor does Soulanille include such a teaching or suggestion.

Thus, for at least the aforementioned reasons and the reasons set forth in the Appeal Brief, the alleged combination of Soulanille, the anonymous article “Google Comes Out Ahead,” and Bates fails to teach or suggest at least this claim recitation of claim 38 and therefore the rejection of claim 38, as well as all claims depending therefrom, should be reversed.

2. Claims 45 And 46 Are Separately Patentable.

Claim 45 depends from claim 40, which depends from independent claim 38. Claim 46 depends directly from independent claim 38. Claim 45 recites in part:

a first listing and a second listing, wherein a priority metric associated with said first listing is higher than a priority metric associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing.

(Emphasis added.) Similarly, claim 46 recites in part:

comprising a first listing and a second listing and a plurality of per-hit fees, wherein each said listing in said response is associated with at least one said per-hit fee, wherein said per-hit fee associated with said first listing is higher than said per-hit fee associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing.

(Emphasis added.) As argued in the Appeal Brief, (pages 27-28), in contrast to “said second listing is given a more favorable placement than said first listing” as recited in Appellants’ claims, Soulanille instead discloses a scheme wherein listings are ordered using a weighted random scheme, and therefore Soulanille fails to teach or suggest at least these elements of claims 45 and 46. (Soulanille, col. 21, line 51 – col. 22, line 50.)

The Examiner responded to Appellants’ foregoing arguments by saying that they were “like arguing that a prior art disclosure of a tray enabling a waiter to carry from one to six drinks does not teach or suggest carrying two drinks on the tray, because there is no explicit teaching of that situation occurring.” (Answer, page 47.) In fact, the Examiner’s analogy is specious. Claims 45 and 46 each include a specific recitation about the more favorable placement of a second listing with respect to a first listing. Not only does the Examiner’s hypothetical not suppose that there is a

more favorable number of drinks to have on the tray, i.e., the Examiner has improperly ignored elements of the claims, but the Examiner has ignored Appellants' argument that Soulanille's random scheme teaches away from the recitation "wherein said second listing is given a more favorable placement," because such "more favorable placement" would destroy Soulanille's random scheme.

Thus, for at least the foregoing reasons and the reasons set forth in the Appeal Brief, claims 45 and 46 are separately patentable.

R. Ground Of Rejection No. 17: Claim 43 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, "Google Comes Out Ahead," Bates, and Might.

Claim 43 depends from claim 41, which in turn depends from claim 40, which in turn depends directly from claim 38. Therefore, claim 43, while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 16.

S. Ground Of Rejection No. 18: Claim 47 Is Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, "Google Comes Out Ahead," Bates, and Littlefield.

Claim 47 depends directly from claim 38. Therefore, claim 47, while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 16.

T. Ground Of Rejection No. 19: Claims 49 and 52-56 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, and Bates.

Independent claim 49 recites in part "each said group being determined at least in part according to said request." Claim 49, as well as all claims depending therefrom, are patentable for at least the reasons discussed above with regard to claim 1. Moreover, there are additional reasons for the patentability of claims 49 and 52-56, discussed below.

1. Watanabe Cannot Be Combined With Soulanille Or Bates.

As argued in the Appeal Brief (page 29), one of ordinary skill in the art would not have thought it possible to combine Watanabe with Soulanille, Bates or any other reference. The Examiner responded to this argument by stating that "the test is not whether one could or would be motivated to bodily incorporate the system of Watanabe into that of Soulanille," but that Watanabe

was used “merely . . . as an example of the well-known technique of inputting programs, files, and particular criteria into computers.” (Answer, page 48.) If this is all Watanabe discloses that is relevant to Appellants’ claims, then, as discussed in the next section, the rejection of claim 49, as well as all claims dependent therefrom, should be reversed because Watanabe plainly does not compensate for the acknowledged deficiencies of the other references.

2. The Combination of Soulanille, Watanabe, And Bates Does Not Teach Or Suggest All Of The Elements Of Appellants’ Claims.

Claim 49 recites, in part, “inputting the tier criteria to define the number of tiers in the response and the number of listings within the tiers.” In the Answer, as discussed above, the Examiner simply asserted that Watanabe taught that inputting files and “particular criteria” into computers was well known. Even so, the Examiner has provided no teaching or suggestion from Watanabe or any other reference relating to “inputting the tier criteria,” much less defining “of the number of tiers in the response and the number of listings within the tiers.” The mere disclosure of inputting files and criteria into a computer does not address these specific recitations of claim 49.

For at least these reasons and reasons set forth in the Appeal Brief, the rejection of claim 49, as well as all claims dependent therefrom, should be reversed.

U. Ground Of Rejection No. 20: Claim 50 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, Bates, and Thomann.

Claim 50 depends from claim 49. Claim 50 recites “[t]he method of claim 49, further comprising associating a particular type of placement heuristic to coincide with a particular type of request.” As argued in the Appeal Brief (page 30), Thomann is directed to managing workflow in pension products (Thomann, Title, Abstract), and includes no teaching or suggestion related to “a particular type of placement heuristic,” much less a placement heuristic that coincides “with a particular type of request.” The Examiner responded that he had cited Thomann for “a piece of ordinary wisdom, . . . namely that ‘numerous variations may be used as appropriate to particular business use.’” Without disputing this “ordinary wisdom,” Appellants respectfully note that the Examiner has provided no reference that discloses the specific recitation of claim 50. Just because in general a business may use “variations,” does not mean that it would have been obvious to associate “a particular type of placement heuristic to coincide with a particular type of request.”

In sum, the Examiner has provided no reference directed to “a particular type of placement heuristic” coinciding “with a particular type of request.” Therefore, for these reasons and reasons set forth in the Appeal Brief, claim 50 is separately patentable and the rejection of claim 50 should be reversed.

V. Ground Of Rejection No. 21: Claim 51 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, Bates, and Might.

Claim 51 depends directly from claim 49. Therefore, claim 51 (and not claim 43, as stated in Appeal Brief), while not argued separately in this appeal, is patentable at least for the reasons set forth above concerning Ground of Rejection No. 19.

CONCLUSION

In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 66703-0014, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: October 28, 2011

Respectfully submitted,

Electronic signature: /Charles A. Bieneman/
Charles A. Bieneman
Registration No.: 51,472
Michael B. Stewart
Registration No.: 36,018
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 10291
Attorneys for Appellants